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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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White & Case Patent Department 1155 Avenue of The Americas New York, NY 10036-2787				
EXAMINER				
MCEVOY, THOMAS M				
ART UNIT		PAPER NUMBER		
3731				
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

09/380,519

Applicant(s)

HORPPU ET AL.

Examiner

THOMAS MCEVOY

Art Unit

3731

Period for Reply -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 14 October 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-9 and 15-18 is/are pending in the application.
- 4a) Of the above claim(s) 17 and 18 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1, 2, 3-9, 15 and 16 is/are rejected.
- 7) ☒ Claim(s) 17 and 18 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/C)
- 4) ☐ Interview Summary (PTO-413)
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____
- Paper No(s)/Mail Date _____

DETAILED ACTION

1. Currently claims 1, 2, 3-9 and 15-18 are pending. Claims 3, 4, 10-14 and 19-21 have been cancelled. Claims 17 and 18 have been withdrawn. Claims 1, 2, 3-9, 15 and 16 are considered below.

Claim Objections

2. Claims 17 and 18 are objected to under 37 CFR 1.121(c) because the current status of the claims is not given. The claims should be resubmitted in a separate paper and claims 17 and 18 should be indicated as withdrawn.

Claim Rejections - 35 USC § 112

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claims 15 and 16 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The term "surgical kit" in claim 15 adds no structural or functional limitation to the claim. No other limitations are present in the claim.

Claim Rejections - 35 USC § 102

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

6. Claims 1, 2, 5-9, 15, and 16 are rejected under 35 U.S.C. 102(b) as being anticipated by Clark et al. (US 5,643,290).

Regarding claims 1 and 6, Clark et al. disclose a mounting apparatus for mounting an endless cord 18 which is expandable from a contracted condition to an expanded condition (Figure 2 vs. Figure 8) onto an end of a structure 10 having a transverse dimension greater than that of the cord when in the contracted condition. The apparatus comprises a tapered adaptor 10 for the cord to be propelled over onto the end of the structure. The adaptor has a forward smaller end (16) for location in the cord in its contracted condition and a rear larger end (12) for juxtaposing with the end of the structure (Figure 1). The apparatus further comprises an expander device 90 movable relative to the adaptor to propel the cord over the adaptor onto the rear larger end thereof, wherein the adaptor comprises a plurality of circumferentially spaced-apart fingers (defined by grooves 40, 42, 44, 46) which extend from the rear larger end towards the forward smaller end and the expander device comprises a plurality of circumferentially spaced-apart arms (defined by walls 100, 102, 104, 106; Figure 5A) insertable between the fingers of the adaptor (Figure 8), and wherein the arms 102 and 106 (Figure 6) of the expander device are tapering in a radial direction towards the center. Regarding claims 2 and 5, the expander device is operable in a first mode thereof to propel the cord over the adaptor onto the rear larger end and in a second mode to propel the cord over the rear larger end and onto the end of the structure (Figure 6 vs. Figure 8) by intermeshing of the adaptor and expander. Regarding claims 7 and 8, the forward smaller end of the adaptor has a central member 16 (Figure 1). Regarding claim 9, the expander device includes a tubular section adapted to slide over the adaptor to propel the cord from the rear larger end thereof onto the end of the

structure (the expander 90 is tubular; Figure 8). Regarding claims 15 and 16, the surgical device 74 is capable of ligating an internal body tissue.

Response to Arguments

7. Applicant's arguments filed October 14th 2008 have been fully considered but they are not persuasive. Applicant argues that claim 15 was treated as an independent claim during its filing and therefore does not need to further limit a parent claim. Examiner respectfully disagrees. Claim 15 at its initial filing and during restriction did not properly depend from any claim and was therefore treated as an independent claim. Applicant amended claim 15 after the restriction requirement to properly depend from the claims of Invention I. Due to this amendment the claim currently stands as a dependent claim and must therefore further limit its parent claim(s). Applicant argues that Clark et al. do not disclose that the spaced apart arms (92/100, 94/102, 96/104, 98/106) taper in a radial direction toward the center. Examiner respectfully disagrees and believes that the claimed tapering is clearly shown by Figure 5A of Clark et al. Applicant argues that the arms of Clark et al. do not cooperate with the fingers of the adaptor. Examiner believes that a cooperation is clearly shown by, for example, Figure 8 of Clark et al. It is not clear which, if any, claim limitation is referred to by the cooperation argument.

Conclusion

8. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Thomas Mcevoy whose telephone number is (571) 270-5034. The examiner can normally be reached on M-F, 9:00-6:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Todd Manahan can be reached on 571-272-4713. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

10. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a

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USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

TM

/Todd E Manahan/
Supervisory Patent Examiner, Art Unit 3731